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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,970	07/26/2001	Daniel C. Castle	10005874-1	8587

7590

07/15/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

STEVENS, ROBERT

ART UNIT PAPER NUMBER

2176

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/916,970	Applicant(s) CASTLE, DANIEL C.	
	Examiner Robert M Stevens	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 are pending in Application No. 09/916,970, entitled "Advertisement Selection Engine for Placing Micro-Advertisement", filed 7/26/2001.
2. The Office acknowledges the IDS filed on 7/26/2001.

Drawings

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because (in Figure 3) reference character "325" has been used to designate both "Has user seen micro-advertisement" diamond and "Place micro-advertisement" rectangle.
5. The drawings are also objected to because in Figure 3, there is no connecting arrow between 325 (should be "355") and 360.
6. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and

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appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7. The disclosure is objected to because of the following informalities:

- a. Page 2 line 2: "deliver" should be "delivery"; and
- b. Page 3 line 1: "content is news related is comprises a" is grammatically incorrect.

Please correct all spelling/grammatical/etc. issues throughout the specification.

8. Additionally, the specification is objected to because:

- a. Page 3 lines 19-30: the drawings label Fig. 3 step 310 as "Determine White Space Available & Demographics", yet there is no description of the process of determining white space availability in the specification; and
- b. Page 3 lines 19-24 describe step 310 as a selection step, which does not correspond to the label within element #310 of Fig. 3.

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Please explain.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 1 – 20 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, there is a lack of enablement regarding “determining available space on the page for the micro-advertisement, the available space not interfering with the information content”.

Claims 2-5 are rejected by virtue of their dependency upon claim 1.

Regarding claim 6, there is a lack of enablement regarding “determining available space on the page for the plurality of micro-advertisements, the available space not interfering with the information content;”.

Claims 6-8 are rejected by virtue of their dependency upon claim 6.

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Regarding claim 9, there is a lack of enablement regarding "determining available space on the page for the micro-advertisements, the available space not interfering with the information content".

Claims 10-13 are rejected by virtue of their dependency upon claim 9.

Regarding claim 14, there is a lack of enablement regarding "determining available space on the page for the micro-advertisements, the available space not interfering with the information content".

Claims 15-16 are rejected by virtue of their dependency upon claim 14.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined

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under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. **Claims 1-4 are rejected under 35 USC 102(e)** as being anticipated by Cottingham (US Patent No. 6,339,761, filed May 13, 1999 and issued Jan. 15, 2002, hereafter referred to as "Cottingham").

Regarding independent method claim 1, Cottingham discloses:

A method for placing a micro-advertisement on a page comprising information content, the method comprising the steps of:

determining available space on the page for the micro-advertisement, the available space not interfering with the information content, (Fig. 3, see top two web pages [i.e., elements #32] in which micro-advertisement is identified and removed)

selecting the micro-advertisement, from a plurality of micro-advertisements, to place on the page; (col. 6 lines 49-53 "selects an advertisement") and

placing the micro-advertisement on the page in the available space. (fig 3 [refer to the middle two elements numbered #32] and col. 6 lines 52-53, in which old ad is removed and new ad is inserted)

Regarding claim 2, which is dependent upon claim 1, Cottingham discloses:

further including the step of transmitting the page to a consumer. (col. lines 54-55)

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Regarding claim 3, which is dependent upon claim 1, Cottingham

discloses:

further including the step of transmitting the page to a consumer over the Internet. (col. 6 lines 54-55, noting that an ISP is an Internet Service Provider)

Regarding claim 4, which is dependent upon claim 2, Cottingham

discloses:

wherein the step of selecting includes the step of determining the consumer's heuristics. (col. 6 lines 1-17, regarding demographics, Internet usage, purchasing preferences, etc.)

13. **Claims 6-11, 14, 15, and 17-19 are rejected under 35 USC 102(e)** as being anticipated by Gupta et al. (US Patent No. 6,487,538, filed Nov. 16, 1998 and issued Nov. 22, 2002, hereafter referred to as "Gupta").

Regarding independent method claim 6, Gupta discloses:

A method for exposing a consumer to advertisements by placing a plurality of micro-advertisement on a page comprising information content, the method comprising the steps of:

determining available space on the page for the plurality of micro-advertisements, the available space not interfering with the information content; (col. 11, lines 14-21 [especially "empty slot"] and lines 41-42 ["multiple advertisements may fit within the advertisement slot"])

determining a value for each of the plurality of micro-advertisements; (col. 11 lines 55-65, regarding "advertisement pricing")

selecting the plurality of micro-advertisements, from a pool of micro-advertisements, in response to the available space and the value; (col. 11 lines 35-42) and

placing the plurality of micro-advertisements on the page in the available space. (col. 11 lines 40-42)

Regarding claim 7, which is dependent upon claim 6, Gupta discloses:

further including the step of transmitting the page to the consumer. (col. 6 lines 10-13 and col. 11 lines 1 and 2, discussing inserting the ad and sending it to the client/consumer)

Regarding claim 8, which is dependent upon claim 6, Gupta discloses:

further including the step of transmitting the page to the consumer over the Internet. (col. 9 lines 1-3 and col. 11 lines 1-2, discussing an Internet connection between a proxy and a client/consumer)

Regarding independent method claim 9, Gupta discloses:

A method for advertising to a consumer over the Internet, from an information service provider, using micro-advertisements on a page comprising information content, the method comprising the steps of:

receiving a request for information content from the consumer; (col. 10 lines 64-65, "client 400 requests a URL from web server 404")

formatting the information content on the page; (col. 10 line 64 continuing over to col. 11 line, discussing "retrieval" of content, insertion of ad, and forwarding the completed package [i.e., the formatted content and the ads])

determining available space on the page for the micro-advertisements, the available space not interfering with the information content; (col. 11 lines 1-2 and 14-21, discussing an empty slot and inserting [line 1] or replacing)

selecting the micro-advertisements in response to the available space; (col. 11 lines 27-34) and placing the micro-advertisements on the page in the available space. (col. 11 lines 40-42)

Regarding claim 10, which is dependent upon claim 9, Gupta discloses:

wherein the step of selecting comprises selecting the micro-advertisements from a pool of micro-advertisements. (col. 11 lines 2-4, especially "multiple advertisements may be stored ... in a database")

Regarding claim 11, which is dependent upon claim 9, Gupta discloses:

wherein and further including the step of transmitting the page over the Internet to the consumer. (col. 9 lines 1-3 [Internet access] and col. 11 lines 1-2 [transmission to consumer/client])

Regarding independent method claim 14, Gupta discloses:

A method for advertising to a consumer over the Internet, from an information service provider, using micro-advertisements on a page comprising information content, the method comprising the steps of:
the information service provider receiving a request for predetermined information content from the consumer; (col. 10 lines 64-65, "client 400 requests URL from web server 404")
formatting the information content on the page; (col. 10 lines 56-61, noting "tailored content")
determining available space on the page for the micro-advertisements, the available space not interfering with the information content; (col. 11 lines 14-21)
determining a value for each of the plurality of micro-advertisements; (col. 11 lines 55-65, regarding "advertisement pricing")
selecting the micro-advertisements in response to the available space and the value; (col. 11 lines 27-34)
placing the plurality of micro-advertisements on the page in the available space; (col. 11 lines 40-42) and

transmitting the page to the consumer. (col. 9 lines 1-3 [Internet access] and col. 11 lines 1-2 [transmission to consumer/client])

Regarding claim 15, which is dependent upon claim 14, Gupta discloses:

wherein the step of selecting comprises selecting the micro-advertisements from a pool of micro-advertisements stored on the service provider's Web server. (col. 10 lines 32-37 and col. 11 lines 2-4)

Regarding independent system claim 17, Gupta discloses:

A system for placing micro-advertisements on a page comprising information content intended for a consumer, the system comprising:
a processor (Fig. 2 #213) that controls processes for placing micro-advertisements in response to micro-advertisement selection criteria; (col. 11 lines 25-42, regarding profiles and fitting multiple advertisements in an advertisement slot)
memory coupled to the processor (Fig. 2 #215), the memory storing the micro-advertisement selection criteria used by the processor; (col. 9 lines 14-25, regarding profile information)
storage media coupled to the processor (Fig. 2 #212), the storage media storing the page of information content (col. 9 lines 1-9 and 38-41), a plurality of micro-advertisements (col. 10 lines 57-59), and a plurality of micro-advertisement selection criteria associated with each micro-advertisement (col. 9 lines 14-25); and
input/output apparatuses coupled to the processor, the input/output apparatuses comprising means for transmitting (Fig. 2 #220 and 221) the page comprising the information content and the micro-advertisement (col. 6 lines 10-13 and col. 11 lines 1-2).

Regarding claim 18, which is dependent upon claim 17, Gupta discloses:

wherein the storage media comprises means for storing consumer profiles. (col. 9 lines 34-45, discussing profiles)

Regarding claim 19, which is dependent upon claim 17, Gupta discloses:

wherein the input/output apparatuses comprise an Internet interface that couples the system to the Internet. (col. 8 lines 1-8, discussing an Internet connection)

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claim 5 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Cottingham (US Patent No. 6,339,761, filed May 13, 1999 and issued Jan. 15, 2002, hereafter referred to as "Cottingham") in view of Gupta et al. (US Patent No. 6,487,538, filed Nov. 16, 1998 and issued Nov. 22, 2002, hereafter referred to as "Gupta").

Regarding claim 5, which is dependent upon claim 2, the elements of claim 2 were previously discussed (see above section regarding 35 USC 102(e) rejections). Cottingham, however, does not explicitly disclose:

wherein the step of selecting includes the step of determining a value for the micro-advertisement.

Gupta, though, discloses:

wherein the step of selecting includes the step of determining a value for the micro-advertisement. (col. 11 lines 55-65, discussing advertising pricing)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Gupta for the benefit of Cottingham because to do so would enable a price value to be adjusted by the opportunity cost that the advertisement cannot be shown as taught by Gupta in col. 11 lines 62-65.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Gupta for the benefit Cottingham because these references were all applicable to the same field of endeavor, i.e., Internet advertising.

16. **Claims 12, 13, 16 and 20 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Gupta et al. (US Patent No. 6,487,538, filed Nov. 16, 1998 and issued Nov. 22, 2002, hereafter referred to as "Gupta") in view of Davis et al (US Patent No. 6,269,361, filed May 28, 1999 and published July 31, 2001, hereafter referred to as "Davis").

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Regarding claim 12, which is dependent upon claim 9, the elements of claim 9 were previously discussed (see above section regarding 35 USC 102(e) rejections). Gupta, however, does not explicitly disclose:

*further including the step of the service provider
accumulating the information content from various sources.*

Davis, though, discloses:

*further including the step of the service provider
accumulating the information content from various sources. (Fig. 7,
showing information content from various sources [as a result of a
search query])*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Davis for the benefit of Gupta because to do so would enable a customer to view a prioritized or ranked search result list as taught by Gupta in col. 18 lines 4-11.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Davis for the benefit Gupta because these references were all applicable to the same field of endeavor, i.e., Internet advertising.

Regarding claim 13, which is dependent upon claim 9, the elements of claim 9 were previously discussed (see above section regarding 35 USC 102(e) rejections). Gupta, however, does not explicitly disclose:

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*further including the step of the service provider
accumulating the information content from the service provider's
Web Server.*

Davis, though, discloses:

*further including the step of the service provider
accumulating the information content from the service provider's
Web Server. (col. 9 lines 8-18, discussing search listing records
used to generate search results)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Davis for the benefit of Gupta because to do so would enable a customer to view a prioritized or ranked search result list as taught by Gupta in col. 18 lines 4-11.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Davis for the benefit Gupta because these references were all applicable to the same field of endeavor, i.e., Internet advertising.

Regarding claim 16, which is dependent upon claim 14, the elements of claim 14 were previously discussed (see above section regarding 35 USC 102(e) rejections). Gupta, however, does not explicitly disclose:

*further including the step of the service provider
accumulating the information content from various information
sources.*

Davis, though, discloses:

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further including the step of the service provider accumulating the information content from various information sources. (Fig. 7, showing information content from various sources [as a result of a search query])

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Davis for the benefit of Gupta because to do so would enable a customer to view a prioritized or ranked search result list as taught by Gupta in col. 18 lines 4-11.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Davis for the benefit Gupta because these references were all applicable to the same field of endeavor, i.e., Internet advertising.

Regarding claim 20, which is dependent upon claim 17, the elements of claim 17 were previously discussed (see above section regarding 35 USC 102(e) rejections). Gupta further discloses:

wherein the storage media comprises a disk drive (Fig. 2 #212, mass storage) for storing the plurality of micro-advertisements (col. 10 lines 51-59), and the plurality of micro-advertisement selection criteria associated with each micro-advertisement (col. 9 lines 14-25).

Gupta, however, does not explicitly disclose:

wherein the storage media comprises a disk drive for storing the page of information content.

Davis, though, discloses:

wherein the storage media comprises a disk drive for storing the page of information content (col. 9 lines 8-18, especially "search database 40 comprised of search listing records").

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Davis for the benefit of Gupta because to do so would enable a customer to view a prioritized or ranked search result list as taught by Gupta in col. 18 lines 4-11.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Davis for the benefit Gupta because these references were all applicable to the same field of endeavor, i.e., Internet advertising.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Non-patent Literature

Anderson, Corin R., et al., "Personalizing Web Sites for Mobile Users", WWW10, Hong Kong, May 1-5, 2001, pp. 565-575 (ACM 1-58113-348-0/01/0005).

Arlein, Robert M., et al., "Privacy-Preserving Global Customization", EC '00, Minneapolis, MN, October 17-20, 2000, pp. 176-184 (ACM 1-58113-272-7/00/0010).

Bjork, Staffan, et al., "WEST: A Web Browser for Small Terminals", UIST '99, Asheville, NC, Nov. 1999, CHI Letters vol. 1, 1, pp. 187-196 (ACM 1-58113-075-9/99/11).

Gralla, Preston, How the Internet Works, Special Edition, Ziff-Davis Press, Emeryville, CA, © 1997, pp. 266-271.

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Chen, Jinlin, et al., "An Adaptive Web Content Delivery System", International Conference on Adaptive Hypermedia and Adaptive Web-based Systems (AH2000), August 28-30, 2000, pp. 1-4.
(<http://research.microsoft.com/research/pubs/view.aspx?type=Publication&id=895>)

Yang, Yudong, et al., "Adaptive Delivery of JTML Contents", 9th International World Wide Web Conference, Poster Proceedings, Amsterdam, The Netherlands, May 15-19, 2000, pp. 24-25.
(<http://research.microsoft.com/research/pubs/view.aspx?type=Publication&id=894>)

Zhang, HongJiang, "Adaptive Content Delivery: A New Research Area in Media Computing", Proceedings of the 2000 International Workshop on Multimedia Data Storage, Retrieval, Integration and Applications, Hong Kong, January 13-15, 2000, pp. 1-4.
(<http://research.microsoft.com/research/pubs/view.aspx?type=Publication&id=905>)

US Patent Application Publications

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Wen	2001/0047297
Uyama et al	2001/0049624
Agassy et al	2002/0004819
Robotham et al	2002/0015042
Robotham et al	2002/0015064
Kanter	2002/0032608
Doherty et al	2002/0095332
Dutta	2002/0109729
Borger et al	2002/0123334
Pedersen	2002/0133404
Huat	2002/0133565
Hosea et al	2002/0138331

US Patents

Gabbard et al	6,205,432
Roth et al	6,285,987
Mason et al	6,401,075
Mahoney et al	6,665,841

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M Stevens whose telephone number is (703) 605-4367. The examiner can normally be reached on M-F 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Stevens
Art Unit 2176
Date: July 9, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

rms